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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,165	04/09/2001	Junichi Ohgo	Q63951	6557

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037-3202

EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,165

Applicant(s)

OHGO, JUNICHI

Examiner

Dominic D. Saltarelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Examiner respectfully requests the applicant submit a full copy of the foreign priority document JP2000-107037 in order to perfect the application.

Response to Arguments

2. Applicant's arguments filed September 2, 2005 have been fully considered but they are not persuasive.

First, applicant argues that Bowcutt does not teach or suggest entering data indicating an operation desired by a user using a telephone (applicant's remarks, page 9).

In response, examiner notes that Bowcutt teaches using a cellular telephone to provide an upstream communications path on col. 8, lines 3-6. The example provided in Bowcutt in col. 9, lines 17-41, regarding the use of a personal computer to input operational data, cited by the applicant, is misleading when taken out of context. First, the example provided is applied only when the upstream path is provided by a cable modem (cable modem 106, col. 9, lines 17-24), contrary to the previously cited section which stated the upstream path is provided by a cellular telephone. Second, the host device 108, cited to be a personal computer, is not so limited, as the host devices include "...personal computers, game players, intelligent telecommunications apparatus, work stations, television/web browser, or other user apparatus" (col. 9, lines 17-21). As such, when the Bowcutt reference is considered as a whole, it does in fact

teach using a telephone to enter data indicating an operation desired by a user using a telephone, because the return path is provided by a cellular telephone, which is an intelligent telecommunications apparatus, on which the user inputs operation data.

Second, applicant argues that there is no reasonable expectation that the references may be successfully modified in view of each other, stating that the decoder of Dureau is being replaced by the cellular telephone of Bowcutt, which is incapable of receiving and decoding Internet data and outputting decoded Internet data to a TV for display (applicant's remarks, page 10, second paragraph).

In response, there is no reason to believe the decoder of Dureau is being replaced in its entirety by the cellular telephone of Bowcutt. Quite to the contrary, the teachings of Bowcutt show there is a very reasonable expectation of success for the proposed combination. As shown in fig. 1 of Bowcutt, the host devices 108 correspond to TV 50 shown in fig. 1 of Dureau, and the RF Modem 106 shown in fig. 1 of Bowcutt corresponds to decoder 45 in fig. 1 of Dureau, and the Cable Plant 105 shown in fig. 1 of Bowcutt corresponds to satellite 35 shown in fig. 1 of Dureau. The RF Modem 106 is shown to use a telephone line as a return path (Tel. Line 131), which is enabled by the specification of Bowcutt to be provided by a cellular telephone over a cellular network (Bowcutt, col. 8, lines 3-6). Bowcutt does not, however, attempt to teach the cellular telephone also must

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receive downstream data from cable 132, the cellular telephone is used **only** for the "slower speed upstream path" (Bowcutt, col. 8, lines 3-6). Because of the structural similarities between Bowcutt and Dureau, a combination of Dureau and Bowcutt is enabled in much the same manner as the use of a cellular telephone for upstream communications is enabled by Bowcutt alone. Namely, the use of a cellular telephone is used only for return channel 57 (shown in fig. 1 of Dureau) in the same enabled manner that it is used for telephone line 131 (shown in fig. 1 of Bowcutt).

3. Applicant's arguments with respect to claims 2 and 7 have been considered but are moot in view of the new grounds of rejection necessitated by the amendment to claims 1 and 6.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 6, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dureau et al. (6,118,472, of record) [Dureau] in view of Bowcutt et al. (6,308,328, of record) [Bowcutt].

Regarding claims 1 and 6, Dureau discloses a method and system for using the Internet comprising:

Using a telephone line to send a request indicating an operation desired by a user and sending the request to a provider's server (col. 4, lines 29-40, wherein the provider's server is service provider 13 shown in fig. 1);

Said provider's server (13) receives the request from said telephone line to carry out the operation desired by the user based on the request (via port 68, col. 4, lines 29-40), said provider's server generates display data showing the result of carrying out the operation (the display data is retrieved Internet data, col. 4, lines 41-50) and sends the display data to a broadcasting station (broadcasting station is broadcast center 12 shown in fig. 1, which receives the Internet data for broadcast, col. 3, lines 51-60 and col. 4, lines 41-50);

Said broadcasting station (12) which receives the display data from said provider's server (via port 74 of gateway 70 in fig. 1, col. 4, lines 41-45) and radio-transmits the display data (via satellite transmitter 30 in fig. 1); and

A television set (fig. 1, TV 50) with radio-receives the display data from said broadcasting station (13), said television set displays the result of carrying out the operation based on the display data (col. 4, lines 48-50).

Dureau fails to disclose the request is data sent from a telephone.

In an analogous art, Bowcutt teaches using a cellular phone to provide upstream signaling (col. 7 line 61 – col. 8 line 10), providing a more flexible [untethered] upstream signaling means than a fixed or wired means.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Dureau to include using a cellular phone [telephone] to provide requests upstream, as taught by Bowcutt, for the benefit of a more flexible means to provide requests to the provider's server.

Regarding claims 5 and 10, Dureau and Bowcutt, disclose the method and system of claims 1 and 6, wherein the display data are radio-transmitted/received via a broadcasting satellite (Dureau, fig. 1, satellite 35).

Regarding claims 11 and 13, Dureau and Bowcutt disclose the method and system of claims 1 and 6, wherein the telephone sends the data to a telephone station (Bowcutt, telephone modem pool 133 shown in fig. 1), the telephone station connects the telephone to the Internet (Bowcutt, Internet 150), and wherein the provider's server (Bowcutt, control and management server 111 shown in fig. 1, which provides network control, col. 7 line 61 – col. 8 line 3) accesses the internet (150) to retrieve the data (for billing and provisioning functions).

6. Claims 2, 3, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dureau and Bowcutt as applied to claims 1 and 6 above, and further in view of and Shimomura et al. (6,526,580, of record) [Shimomura].

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Regarding claims 2 and 7, Dureau and Bowcutt disclose the method and system of claims 1 and 6, but fail to disclose the data is entered and sent by the user using an Internet mail function of said telephone.

In an analogous art, Shimomura teaches using an Internet mail function to send data from a wireless device (SMS messages are mail messages being sent to an Internet server for the purpose of interacting with the Internet, col. 14, lines 40-56), for the benefit of providing an Internet back channel that is incorporated as part of existing cellular telephone infrastructure.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Dureau and Bowcutt to include using an Internet mail function to send data from the wireless device, as taught by Shimomura, for the benefit of providing an Internet back channel that is incorporated as part of the existing cellular telephone infrastructure.

Regarding claims 3 and 8, Dureau, Bowcutt, and Shimomura disclose the method and system of claims 2 and 7, wherein said telephone is a mobile phone (Bowcutt teaches using a cellular phone, col. 8, lines 3-6).

7. Claims 4, 9, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dureau and Bowcutt as applied to claims 1 and 6 above, and further in view of Majeti et al. (5,534,913, of record).

Regarding claims 4 and 9, Dureau and Bowcutt disclose the method and system of claims 1 and 6, but fail to disclose said provider's server adds an identification code to the display data, and said television set selects the display data based on the identification code.

In an analogous art, Majeti teaches addressing data to particular users (col. 4, lines 26-45) wherein the data is broadcast to many users over a common broadcast channel (col. 4, lines 7-25), thus the receiver equipment must select received data for display based on the address information included in the broadcast, for the benefit of selectively targeting data to different users over a broadcast distribution network.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Dureau and Bowcutt to include adding an identification code to the display data, and selecting the display data based on the identification code, as taught by Majeti, for the benefit of selectively targeting data to different users for exclusive reception over a broadcast distribution network.

Regarding claims 12 and 14, Dureau and Bowcutt disclose the method and system of claims 1 and 6, but fail to disclose the telephone comprises a first identification code and the television set comprises a second identification code, the first identification code and the second identification code being the same, and wherein the first identification code is registered with the provider's server.

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In an analogous art, Majeti teaches addressing data to particular users (col. 4, lines 26-45) wherein the data is broadcast to many users over a common broadcast channel (col. 4, lines 7-25), for the benefit of selectively targeting data to different users over a broadcast distribution network.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Dureau and Bowcutt to include addressing data to particular users, as taught by Majeti, for the benefit of selectively targeting data to many different users simultaneously over a broadcast distribution network. The addressing information is the identification code associated with the telephone and the television set, as the telephone includes the code when making a request to identify the requester and the television set includes the code in order to filter out that information addressed to the user. The address information is registered with the server, as it is the server which is responsible for receiving and fulfilling requests from users.

Conclusion

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Unit 2611

DS


HAI TRAN
PRIMARY EXAMINER